

REMARKS

The applicants have thoroughly considered the Official Action, dated April 28, 2005, and have prepared this Amendment in response thereto. The applicants thank the examiner for identifying claim 2 as being allowable and have amended claim 1 to include the limitations of allowable claim 2. Claims 2 and 3 were cancelled in light of the amendment of claim 1. Claim 9 was amended to include the limitation of allowable claim 2, claims 10 and 11 were cancelled in light of this amendment, and claims 15 and 16 were amended to change their dependency from cancelled claim 10 to claim 9. New independent claim 17 was added, which includes all of the limitations of claim 4, and new dependent claims 18 – 22 were added to depend from claim 17. Claims 1, 4-9 and 12 - 22 are pending in the application.

The following remarks will follow the order set forth in the Office Action.

Election/Restriction

The applicants acknowledge the withdrawal of claims 9 – 16 from consideration. Given the examiner's statement that claim 2 is allowable, and the amendment of claim 1 to include the limitations of claim 2, the applicants have likewise amended claim 9 to include the limitation of claim 2. Therefore, the device for holding an object that is a subcombination of the combination of the assembly of claim 9 includes each and every limitation of the device claimed in amended claim 1. The applicants understand that new independent claim 17 does not include all of these limitations and, were claims 17 – 22 allowed, the withdrawn claims would be properly cancelled from the application. However, the applicants have made these amendments to ensure that the withdrawn claims do not have two-way distinctiveness with allowable claim 1 in the event that new

claims 17 – 22 are found to be subject to final rejection.

With regard to the restriction requirement, the applicants note the examiner's reference to claim 6, which limits the subcombination to pins "dimensioned to grip an inside diameter of a bore". However, the applicants respectfully assert that independent claim 1, and not dependent claim 6, is the relevant subcombination claim for purposes of establishing two-way distinctiveness under MPEP §806.05(c). Given the fact that the combination claim 9 includes all of the limitations of the device subcombination of claim 1, the applicants incorporate by reference the arguments made in their Response to Restriction Requirement, filed on March 1, 2005.

Rejections Under 35 U.S.C. §102 and §103

Claims 1, 3, 4 and 6-8 were rejected under 35 U.S.C. §102 and claim 5 was rejected under 35 U.S.C. §103. For the reasons set forth below, the applicant respectfully disagrees with the rejection of original claims 4 and 5 and have added new claims 17 – 22, which include the limitations of these claims.

In response to these rejection of independent claim 1, the applicants have amended independent claim 1 include all of the limitations of allowable claim 2. Accordingly, the applicants assert that these rejections are rendered moot by the amendment of claim 1 and that claims 1, as amended, and claims 4 – 8 that depend from claim 1, are allowable. Therefore, the applicant respectfully request that the examiner reconsider these rejections in light of the amendment and allow claims 1 and 4 – 8.

New independent claim 17 includes all of the limitations of original claim 4, which was rejected as anticipated by the '276 patent. The applicants respectfully disagree with this rejection. In particular, Claim 17, and original claim 4, include the

limitations that the device comprise “at least three linkages dimensioned to rotationally link each of said followers such that movement of one of follower causes all of said followers to pivot synchronously”. The device of the ‘276 patent fails to disclose or suggest such a limitation.

The ‘276 patent discloses a number of different embodiments, each of which includes a common drive means, as noted in the Office Action. However, none of the embodiments disclose or suggest the use of at least linkages, as claimed in claim 17. Accordingly, new claim 17, cannot be anticipated by the ‘276 patent.

The applicants concede that a device having at least three linkages is described in connection with the device of the ‘336 patent cited in the rejection of claim 1. However, as properly noted by the examiner in failing to reject original claim 4 under 35 USC §102 based upon this patent, the ‘336 patent does not claim the use of pins as the gripping portions. The issue, therefore, is whether the combination of the ‘276 patent and the ‘336 patent would render claim 17 obvious. The applicants respectfully assert that it does not.

MPEP § 2142 states that “(t)o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all of the claim limitations.” The applicants assert that there is no motivation to combine these references to obtain the applicants’ claimed invention and, were they combined, there would be no reasonable expectation of success from such a combination.

First, the applicants assert that it would not be obvious to modify the device of the '336 patent to include the pins claimed in the device of claim 17. The '336 patent describes a holding system for holding logs of paper during a cutting operation. Each clamping element (27) includes a flat surface (29), which contacts the paper log. These surfaces are flat due to the fact that the centerline of the system is variable to accommodate logs of different diameters, with the result being that the clamping elements (27) are disposed at different angles and, consequently, different portions of the flat surface (29) come into contact with the paper roll. *See '336, FIGS. 1 & 2, and col. 4, lines 12 – 60.* Because of the variation of this angle, and the requirement that different points on the flat surface (29) of the clamping element (27) come into contact of the flat surfaces onto the paper roll, there would be no motivation to modify this device to include the pins claimed in claim 17. Further, even if such a combination were made, it would have no likelihood of success due the fact that the pin would not contact the paper roll at different angles. Therefore, the applicants assert that it would not be obvious to modify the '336 patent to include the claimed pins.

Second, the applicants assert that there would be no motivation to modify the device of '276 patent to include the linkages claimed in claim 17. The '276 patent states that a main disadvantage of known handling devices is that the clamping elements move along arcs of a circle, which allows the workpieces to be inadvertently turned then they are gripped by the clamping elements. *See '276, col. 1, lines 24-32.* It then states that one of its objects "is to create a device for handling workpiece in which, firstly, the clamping elements move exactly in a radial direction and in straight lines in relation to the center of the workpiece so that the disadvantages of the known pivot lever

constructions may be avoided". '276, col. 1, lines 36 – 42. Conversely, the use of the linkages claimed in the device of the applicants' claim 17 would not provide pure radial movement, but rather would create the same movement along arcs of a circle that the '276 patent seeks to avoid. Given the '276 patent's stated object of creating a clamping device in which the clamping elements move in a radial direction, the '276 patent teaches away from the use of the linkages claimed in claim 17. Therefore, the applicants assert that there would be no motivation to modify the '276 patent to include the linkages of the '336 patent and that such a modification would not be successful at achieving the objects set forth in the '276 patent.

For the reasons set forth above, it is asserted that new claims 17 – 22 are novel and unobvious. Therefore, the applicants respectfully request that the examiner consider these claims in light of the above remarks and allow claims 17- 22.

Conclusion

It is felt that a full and complete response has been made to the Official Action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. If the examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, the examiner is invited to phone the applicants' attorney at the number set forth below.

Respectfully submitted,

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